REMARKS

Favorable reconsideration of this application, in view of the present amendment and in light of the following discussion, is respectfully requested.

Claims 2-9, 11-22, and 24-34 are currently pending. Claim 31 has been amended by the present amendment. No new matter has been added.

In the outstanding Office Action, Claim 31 was objected to as containing an informality; and Claims 2-9, 11-22, and 24-34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,794,235 to Chess (hereinafter "the '235 patent") in view of U.S. Patent No. 5,982,370 to Kamper (hereinafter "the '370 patent").

Applicants respectfully submit that the objection to Claim 31 is rendered moot by the present amendment to that claim.

Claim 2 is directed to a method of managing information, comprising: (1) identifying, by a user, from all words in an image, a word of the image as a keyword, prior to performing a search using the keyword; (2) determining a search result corresponding to the keyword; (3) displaying, on a display unit, a pop-up menu prepared based on a content of the search result, the pop-up menu including a list of selectable documents corresponding to the content of the search result; and (4) displaying additional information in response to a selection of a document in the list of documents in the pop-up menu.

Regarding the rejection of Claim 2 under 35 U.S.C. § 103(a), the Office Action asserts that the '235 patent discloses everything in Claim 2 with the exception that "identification of a word of an image as a keyword is prior to performing a search using the keyword,"[1] and relies on the '370 patent to remedy that deficiency.

The '235 patent is directed to a method for monitoring the content of incoming data, such as an email, including the steps of receiving and displaying an electronic mail message,

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[1] See page 4 of the Office Action.

identifying the message or words that are not stop words, and for each identified in the message, searching one or more databases for an occurrence of an item likely to be related to the identified word, and if an occurrence is found, generate a notification message. In particular as shown in the flowchart of Figure 1, the '235 patent discloses a system in which, after a user opens an email, a background thread 12 isolates individual words or tokens within the email, and for each token that is not a stop word, performs a search in a database for information that is likely to be of interest to the user. If the search using the token identifies one or more documents that may be of interest to the user, the token in the email is displayed in a different color to indicate to the user that there is further data available for that token. Further, the '235 patent discloses that <u>the user may select among the tokens that have been colored to receive a pop-up menu that includes a list of the names of documents that have been uncovered in the search on that token</u> and that the user may select one or more documents from the menu.

However, as admitted in the Office Action, the '235 patent fails to disclose the step of <u>identifying, by a user, from all words in an image, a word of the image is a keyword, prior to performing a search using the keyword</u>, as recited in Claim 2. Rather, the '235 patent discloses that the user may select <u>only from colored tokens</u>, which are those tokens or words in an image that are not stop words, and words that have generated a hit in <u>search</u> of the database that is been automatically performed by the system prior to the user being able to select the word in the image. Thus, in the '235 system, the user is not able to select from all words in the image, but is only able to select from words that have already generated a hit in a search of a database. Thus, the '235 system does not disclose the step of identifying, by a user, from all words in an image, a word of the image as a keyword, <u>prior</u> to performing a search using the keyword. In contrast, in the '235 system, all words that are selected by a user have already had a search performed based on that word.

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The '370 patent is directed to a search interface including a highlight tool used to identify search terms in an HTML document displayed on a web browser. The '370 patent discloses that upon selection of text, a pop-up menu appears that offers the user the option of searching for the text. See '370 patent, Figures 5c and 5f. Further, as shown in Figure 5h, the '370 patent discloses a system in which an optional pop-up menu is displayed to allow the user to save links to web pages obtained by a search, without requiring the user to visit the web site.

In the outstanding Office Action, the stated motivation for combining the teachings of the '235 and '370 patents is that the combination enables "a novel interface to an interactive search tool, offering "users a convenient way to select keywords to save a user's time and effort."[2]

However, for the reasons stated below, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and that the rejection of Claim 2 (and all associated dependent claims) should be withdrawn.

First, the '235 patent <u>already discloses</u> a "novel interface to an interactive search tool" that allows "users a convenient way to select keywords to save user's time and effort." See '235 Figure 1. The '235 system has a user interface and has no need of the '370 interface. Rather, the Office is simply engaging in hindsight reconstruction of Applicants' invention.

Further, the issue is whether there is motivation for one of ordinary skill in the art to modify the '235 system so that the automatic search of the tokens and presentation of colored tokens to the user should be abandoned in favor of a system in which the <u>user</u> must select all words to be searched. Applicants submit that, contrary to the assertion by the Office, **such a modification would destroy the intended purpose of the '235 system** and would clearly <u>not</u> "save a user's time and effort." Rather, the suggested combination would completely

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[2] See page 4 of the Office Action.

destroy the purpose and functioning of the '235 system, rendering it meaningless. The pre-

searching of the email in the '235 system, which is the whole point of the '235 system, would

be completely eliminated. Moreover, a user of the system resulting from the suggested

combination would require more time and effort to obtain results relative to that of a user of

the unmodified '235 system.

The '235 patent discloses that the purpose of the '235 system is to save time for busy

people by automatically correlating words or tokens in the user's email with other documents

in a database, so that the user does not have to make the associations himself. Otherwise, a

user might be too busy to make the association or not even be aware of the associations.

Thus, the '235 system conveniently points out associations to a user by automatically

identifying words (colored tokens) in an email that are related to other data of the user. In

particular, the '235 patent states that:

> [l]imits of memory, convenience, attention, and speed,
>
> all apply to the associative duties of the mind. Salient facts and
>
> concepts can go by too fast to be recognized, there may be too
>
> many to pay attention to, there may not be time to follow up on,
>
> or even note down, an important-looking association, or a
>
> valuable association may not be in memory at all, or may be
>
> too deeply buried to be brought to attention when it is needed....
>
> An object of the invention is to provide a system and
>
> method for monitoring incoming data, for instance an
>
> electronic mail message, identifying within the message data
>
> tokens of a predetermined type, and searching one or more
>
> databases for occurrences of those data tokens. In this way, a

> user can readily access data sets relevant to data tokens in the
>
> incoming data set.[3]

However, if the '235 patent is modified as suggested in the Office Action, the automatic searches shown in the left-hand branch of the flowchart in '235 Figure 1 will not be performed and it will be up to the user to select keywords in the email, as taught by the '370 patent. Thus, the user of this combined system would lose all the benefits of a system that automatically finds associations for him. Accordingly, the user could miss many associations or, alternatively, would be forced to manually perform multiple searches to obtain the same information. Thus, rather than saving the user time and effort, the combination suggested in the Office Action would cost the user time and effort.

Moreover, as discussed above, the entire purpose of the '235 system would have been destroyed. *See In re Ratti*, 270 F.2d 810 (CCPA 1959) (reversing an obviousness rejection where the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference's] construction was designed to operate"). Here, the basic principle of the '235 system is to automatically perform searches of a database on keywords in an email and, when matches are found, highlight those words in the email for a user so that a user is saved the time and effort of manually finding the connections. The suggested combination destroys this basic principle.

Stated another way, modifying the '235 patent in the manner suggested would render the '235 patent unsatisfactory for its intended purpose, which is an indicia of non-obviousness under MPEP § 2143.01V.

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[3] '235 patent, column 1, lines 21-38.

Thus, for the reasons stated above, Applicants respectfully submit that one of ordinary skill in the art would not have been motivated to make the combination set forth in the Office Action. Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and that the rejection of Claim 2 (and all associated dependent claims) should be withdrawn.

Independent Claim 31 recites the identifying step recited in Claim 2. Moreover, independent Claims 17 and 30 recite identifying, from all words in the displayed image based on user input, a word displayed in an image to be a keyword, prior to performing a search using the keyword. Accordingly, for the reasons stated above, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and that the rejection of Claims 17, 30, and 31 (and all associated dependent claims) should be withdrawn.

Thus, it is respectfully submitted that independent Claims 2, 17, 30, and 31 (and all associated dependent claims) patentably define over any combination the '235 and '370 patents.

Consequently, in view of the present amendment and in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.
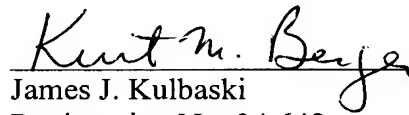
Respectfully submitted,

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